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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,036	12/28/2000	Veronique Ferrari	05725.0832-00	5474

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EXAMINER
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VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/749,036

**Applicant(s)**

FERRARI ET AL.

**Examiner**

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 92-93, 97, 102-104, 113, 115-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 169-170, 172, 177-180, 183, 218-219, 221 and 223 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/4/04</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims pending in the application are 18,92,93,97,102-104,113,115-122,124,127,129,131,132,137,143,144,147,153,157,158,161,169,170,172,177-180,183,218,219,221 and 223.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/4/04 has been entered.

Receipt is acknowledged of remarks and IDS filed on 11/4/04. Receipt is also acknowledged of amendment filed on 3/25/05. Claims 1-91, 94-96, 98-101, 105-112, 114, 123, 125-126, 128, 130, 133-136, 138-142, 145-146, 148-152, 154-156, 159-160, 162-165, 167-168, 171, 173-176, 181-182, 184-217, 220, 222 and 224-287 has been canceled as per applicant's amendment dated 3/25/05.

Claims 92-93, 97, 102-104, 113, 115-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221 and 223 are pending in the application and the status of the application is as follows:

### ***Information Disclosure Statement***

The citations which had a line-through has been considered but will not be listed for printing.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 92-93, 97, 102-104, 113, 115-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221 and 223 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to

*A composition comprising: at least one liquid fatty phase which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and (ii) at least one pasty fatty substance wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.*

**The specification gives no guidance to one of ordinary skill in the art the (i) polymers which are encompassed by this expression and also satisfies the criteria of claims 93, 97, 102-104, 113, 115-118 and 120 wherein the hetero atom group is chosen from carbamate groups and urea groups and said polymer skeleton is chosen from polyurethane skeletons, polyurea skeletons and polyurea-polyurethane skeletons. The specification does not define the polymers or provide structure like formula I when the heteroatom is polyamide group. The definition of "hetero atom which can be any hetero atom or hetero atom which is nitrogen**

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**and this nitrogen belonging to carbamate group or urea group and these groups further having polyurethane skeleton or polyurea skeleton or polyurea and polyurethane skeleton includes** plethora of polymers which has these functional moieties. The specification describes the same language at pages 6-9 of the specification. (ii) There is no description in the specification for the polyamide of formula (I) wherein R3 is chosen from organic groups comprising atoms chosen from carbon atoms, hydrogen atoms, oxygen atoms and nitrogen atoms with the proviso that R3 comprises at least 2 carbon atoms. The description in the specification is only for R3, which can be *identical or different, can, for example, each be chosen from C2 to C36 hydrocarbon-based groups and polyoxyalkylene groups. In another example, R3, which can be identical or different, can each, for example, be chosen from C2 to C12 hydrocarbon-based groups thus the description is for specific moieties and there is no description in the specification when the organic groups comprise atoms chosen from carbon, hydrogen and nitrogen or carbon, hydrogen, oxygen and nitrogen.* (iii) There is no description in the specification when R4, the nitrogen atom to which both R3 and R4 are bonded forms part of a heterocyclic structure defined in part by R4-N-R3. *there is no description in the specification for the heterocyclic rings. The specification gives no guidance to one of ordinary skill in the art, the nature of the ring, i.e., unsaturated or saturated and the size of the ring.*

The expressions **(i) at least one hydrocarbon-based repeating unit comprising at least one hetero atom wherein the hetero atom group is chosen from carbamate groups and urea groups and said polymer skeleton is chosen from polyurethane skeletons, polyurea skeletons and polyurea-polyurethane skeletons or (ii) wherein R3 is chosen from organic groups comprising atoms chosen from carbon atoms, hydrogen atoms, oxygen atoms and**

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**nitrogen atoms with the proviso that R3 comprises at least 2 carbon atoms or (iii) when R4, the nitrogen atom to which both R3 and R4 are bonded forms part of a heterocyclic structure defined in part by R4-N-R3** without complete structure does not convey to one of ordinary skill in the art that applicants were in possession of the claimed subject matter with respect to (i) . The functional language recited without any correlation does not meet the written description requirement for the above expressions as one of ordinary skill in the art could not recognize or understand the structure from the mere recitation of the function with respect to (i) and (ii) and could not recognize the heterocyclic rings with respect to (iii). Claims employing functional language at the point of novelty, such as applicants', neither provide those elements required to practice the inventions, nor "inform the public" during the life of the patent of the limits of the monopoly asserted. The expression could encompass myriad of compounds and applicants claimed expression represents only **an invitation to experiment** regarding possible compounds.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 92-93, 97, 102-104, 113, 115-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 170, 172, 177-180, 183, 218-219, 221 and 223 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The expressions "(i) at least one hydrocarbon-based repeating unit comprising at least one hetero atom wherein the hetero atom group is chosen from carbamate groups and urea groups and said polymer skeleton is chosen from polyurethane skeletons, polyurea skeletons and

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polyurea-polyurethane skeletons or (ii) wherein R3 is chosen from organic groups comprising atoms chosen from carbon atoms, hydrogen atoms, oxygen atoms and nitrogen atoms with the proviso that R3 comprises at least 2 carbon atoms or (iii) when R4, the nitrogen atom to which both R3 and R4 are bonded forms part of a heterocyclic structure defined in part by R4-N-R3” are without metes and bounds. Recourse to the specification does not define the compounds in each category.

7. The expression “ additional fatty material which is selected from gums, fatty materials pasty at ambient temperature and resins” are without metes and bounds. Recourse to the specification does not define the compounds in each category. What are fatty materials which are pasty at ambient temperature?

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 92-93, 97, 102-104, 113, 115-122, 124, 127, 129, 131-132, 137, 143-144, 147, 161, 166, 169-170, 172, 177-180, 218-219, 221 and 223 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,148,125 ('125).

### **Claim construction**

The specification at page 15 defines “ Other non-limiting examples of an at least one polyamide polymer which may be used in the compositions according to the present invention



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include polyamide polymers resulting from the condensation of at least one aliphatic dicarboxylic acid and at least one diamine, the carbonyl and amine groups being condensed via an amide bond. In one embodiment, these polymers contain more than two carbonyl groups and more than two amine groups. Examples of these polyamide polymers are those sold under the brand name Versamid by the companies General Mills Inc. and Henkel Corp. (Versamid 930, 744 or 1655) or by the company Olin Mathieson Chemical Corp. under the brand name Onamid, in particular Onamid S or C. These resins have a weight- average molecular mass ranging from 6000 to 9000. For further information regarding these polyamides, reference may be made to U.S. Patent Nos. 3,645,705 and 3,148,125, the disclosures of which are hereby incorporated by reference. In one embodiment, Versamid 930 or 744 may be used.

The patent discloses Versamid and this has an amide skeleton and claims drawn to formula I are also rejected based upon applicants definition at page 15. If applicants disagree with the examiner that the Versamid does not belong to formula I and does not satisfy any variable of formula I they are requested to provide competent product brochure which shows the structure of the polyamide resins disclosed in the patent.

See examples at col.3. Polyamides disclosed are the same to that claimed as structuring polymer. Lanolin alcohols and ethoxylated lanolin alcohols reads on claimed past fatty substance or the specific compound claimed in the Markush group in this category which is “lanolin derivatives”, castor oil reads on the claimed “oil or apolar oil or non-volatile oil”, PEG esters or Lauryl lactate reads on the claimed amphiphilic compound, dyes reads on the claimed coloring agents, isopropyl alcohol reads on the claimed additive which is “water miscible

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compounds” . Lipstick reads on the claimed lipstick or care product for the skin or a method for care or make-up or treatment of keratin materials.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 92-93, 97, 102-104, 113, 115-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 170, 172, 177-180, 183, 218-219, 221 and 223 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 5,783, 657 ('657); 3,148,125 ('125) and 6, 214, 329 ('329).

The instant application is claiming

1. Polymer of formula I
2. Pasty fatty substance

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3. oil or non-volatile oil (claims 143-144, and 147)
4. Volatile oil (claim 153)
5. Amphilic compound (claim 172)
6. Coloring agent(claims 178-180)
7. Wax (claim 183)
8. Additives ( claim 177)

The patent '657 teaches polymer claimed in the instant application (ingredient 1) having gel consistency and these gels are useful in personal care products where in some self-supporting consistency is desired. See the abstract, see cols. 3-4 and see col.3, line 24 where the patent teaches that these polymers are useful in eye-makeup. The eye make up products are Mascara, eye shadow and eyeliner. The patent suggests the usefulness of this polymer in the eye-make up art. The patent at col.17, lines 25-30 teaches that this polymer can be combined with water, colorants and fillers and also teaches adding volatile solvent. The difference between the patent and the instant application is the patent does not teach the volatile solvent or amphilic compound. The patent '125 also teaches the polymer (Versamid) useful as lipsticks . See the explanation under 102(b). The patent '329 teaches Mascara product using specific volatile oil claimed at col.6, line 60 and at paragraph bridging cols. 8-9 the specific fillers claimed, and at col.9 pigments and under example 1 teaches preservatives which are the parabens. The patent '329 teaches waxes at col.5, lines 15-37. the patent also teaches the combination of waxes, coloring agents, amphilic compounds, volatile and non volatile oils and using this combination with gelling agents

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Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions using the polymer of '657 or '125 and use it as Mascara or lipstick taught by both the patents along with oils, amphilic compounds, additives and oils , pigments, and use the specific volatile solvents and waxes of '329 expecting that the compositions are useful as Mascara or lipstick (cosmetics). The motivation to combine the ingredients flows logically from the art for having been used in the same cosmetic art. One of ordinary skill in the art would be motivated to combine the ingredients with the reasonable expectation of success that the compositions which has the polymer has the structured property and also when this polymer is combined with hydrocarbons( volatile solvent) it becomes transparent . This is prima facie case of obviousness. ,

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday,10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**JYOTHSNA A VENKAT Ph. D**  
**Primary Examiner**  
**Art Unit 1615**

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